

Docket No. **VTN0458**#9
7/17/01
Allied**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

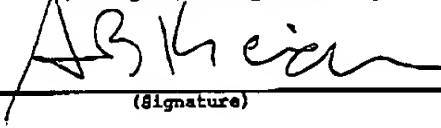
Applicants : Beaton et al.
Serial No. : 09/494,859
Filed : February 01, 2000
Title : Customized Prescription Product Packaging and Method and System for
Producing Customized Prescription Product Packaging

Art Unit : 3721
Examiner : H. Desai

I hereby certify that this correspondence is being faxed to the USPTO
at (703) 305-3579 on

July 16, 2001
(Date of Deposit)

Anne B. Kiernan
(Name of applicant, assignee, or Registered Representative)


(Signature)

July 16, 2001
(Date of Signature)

Honorable Commissioner of Patents
Washington, D.C. 20231

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JUL 17 2001

GROUP 3700

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Office Action of June 14, 2001 that indicated that the claims of the above-referenced application are subject to a restriction requirement. The response due date was July 14, 2001 which was a Saturday; therefore, this response is timely filed.

The Office Action states that there are three inventions. Group I (claims 1-18) is drawn to packaging, Group II (claims 19-29) is drawn to a method of producing packaging and Group III (claims 30-35) is drawn to a graphics printing system. Applicants traverse this restriction requirement; however, to be fully responsive Applicants elect the Group I claims, with traverse.

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The Office Action states:

“Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05 (f)). In the instant case the product as claimed can be made by another and materially different process such as attaching or adhering out customized graphics for the package.

Applicants traverse this restriction requirement, because Applicants do not agree that the inventions are distinct for the reason stated in the Office Action. The broadest claims in Group I and Group II are not limited in such a way as to exclude “attaching or adhering out customized graphics for the package”; therefore, Group I and Group II are not distinct for the reason stated in the Office Action. Therefore, the restriction requirement should be withdrawn, and the claims of Group I and Group II should be considered together in a single application.

The Office Action further states:

“Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product such as printing graphics on a signature.

Applicants traverse this restriction requirement, because Applicants do not agree that the inventions are distinct for the reason stated in the Office Action. Applicants are not sure what is meant by “printing graphics on a signature” but the claims of Group I and III are limited to customized graphics on a prescription product; however, the type of customized graphics is not limited in either Group to exclude signatures, therefore, Group I and Group III are not distinct for the reason stated in the Office Action. Therefore, the restriction requirement should be withdrawn and the claims of Group I and Group III should be considered together in a single application.

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The Office Action further states:

"Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as attaching or adhering customized graphics by hand."

Applicants traverse this restriction requirement, because Applicants do not agree that the inventions are distinct for the reason stated in the Office Action. The broadest claims in Group II and Group III are not limited in such a way as to exclude "attaching or adhering customized graphics by hand"; therefore, Group II and Group III are not distinct for the reason stated in the Office Action. Therefore, the restriction requirement should be withdrawn and the claims of Group II and Group III should be considered together in a single application.

For all the reasons above, and for the additional reason to conserve the limited resources of the PTO, Applicants respectfully request that claims 1-35 be considered together in a single application.

Respectfully submitted,

By: 

Anne B. Kiernan
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Dated: July 16, 2001

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FACSIMILE TRANSMISSIONS COVERSHEET

DATE: July 16, 2001

**TO: Examiner Desai
USPTO**

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JUL 17 2001

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NUMBER OF PAGES INCLUDING THIS COVER SHEET: 4

RE:

Response to Restriction Requirement for Serial No. 09/494,859

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